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7055	7590	08/02/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/832,107	MIYANAGA, HIROSHI	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 June 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 16-26 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 16-26 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 09 May 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/7/05 has been entered.

Response to Amendment

2. Applicant's amendment received on 5/9/05 has been entered and made of record. Currently, **claims 16-26** are pending.

Drawings

3. The corrected drawing was received on 5/9/05. This drawing is acceptable by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 23** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Claim 23** recites the limitation "the electronic mail communication apparatus" in line 14.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 16, 18, 19, 22, 23, and 26** are rejected under 35 U.S.C. 102(e) as being anticipated by Misawa *et al.* (U.S. Patent Number 6,771,382).

Regarding **claim 16**, Misawa discloses an electronic mail communication apparatus (see Fig. 1) transmitting an e-mail to a destination via a mail server (terminal unit 60), the electronic mail communication apparatus comprising a scanner configured to scan image data (image reading unit 15, column 15, lines 7-11), the scanner being distinct from the mail server (see Fig.

1), a memory configured to store a limit capacity of the mail server (RAM 13 or storage unit 20, column 4, line 59-column 5, lines 6), the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission (reference value table, column 5, lines 7-27, and column 7, lines 5-31, whereby the user sets a reference value of a maximum size that is transmitted, which subsequently would inherently indicate the maximum data amount that the mail server can store for one e-mail transmission), and a controller (CPU 11) configured to convert the image data into data for Internet transmission (column 5, line 62-column 6, line 67), to attach the converted data to the e-mail (column 5, lines 16-67), and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server (column 5, line 16-column 6, line 67), the controller being further configured to compare the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server (column 5, line 16-column 6, line 17), and to notify a user of the electronic mail communication apparatus of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server (column 5, lines 43-57, column 6, lines 57-67, see Fig. 6).

Regarding *claim 18*, Misawa discloses the communication apparatus discussed above in claim 16, and further teaches of a display which notifies a user of the electronic mail communication apparatus of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server (display unit 18, column 5, lines 43-57, column 6, lines 57-67, see Fig. 6).

Regarding *claim 19*, Misawa discloses the communication apparatus discussed above in claim 16, and further teaches that the mail server comprises at least a transmitting mail server and a receiving mail server (column 3, line 42-column 4, line 2), and the maximum data amount comprises a smaller of a data amount that the transmitting mail server can store and a data amount that the receiving mail server can store (reference value table, column 5, lines 7-27, and column 7, lines 5-31, whereby the user sets a reference value of a maximum size that is transmitted, which subsequently would inherently indicate the maximum data amount, being the smaller of the data amounts that the mail servers can store).

Regarding *claim 22*, Misawa discloses an electronic mail communication apparatus (see Fig. 1) being connected to a plurality of mail servers and transmitting an e-mail to a destination via one mail server of the plurality of the mail servers (terminal units 60 and facsimile units 80, column 3, lines 43-61), the one mail server being designated for the transmission of the electronic mail communication apparatus (column 6, lines 24-53), the electronic mail communication apparatus comprising a scanner configured to scan image data (image reading unit 15, column 15, lines 7-11), the scanner being distinct from the plurality of mail servers (see Fig. 1), a memory (RAM 13 or storage unit 20) configured to store a limit capacity (column 4, line 59-column 5, lines 6) and an IP address (see Fig. 2, whereby “tanaka@kk.co.jp” is considered an IP address) corresponding to each of the plurality of the mail servers (see Figs. 7 and 8, column 3, lines 43-61, and column 7, lines 21-27), the limit capacity indicating a maximum data amount that the mail server can store (reference value table, column 5, lines 7-27, and column 7, lines 5-31, whereby the user sets a reference value of a maximum size that is transmitted, which subsequently would inherently indicate the maximum data amount that the

mail server can store for one e-mail transmission), and a controller (CPU 11) configured to convert the image data into data for Internet transmission (column 5, line 62-column 6, line 67), to attach the converted data to the e-mail (column 5, lines 16-67), and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server (column 5, line 16-column 6, line 67), the controller being further configured to compare the data amount of the e-mail to which the converted data is attached with the limit capacity of the designated mail server (column 5, line 16-column 6, line 17), to select another mail server that has a capacity to store the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the designated mail server (column 6, lines 13-67), and to transmit, to the destination, the e-mail to which the converted data is attached via another mail server, based on the IP address corresponding to another mail server (column 6, lines 13-67, see Fig. 6).

Regarding *claim 23*, Misawa discloses an electronic mail communication method (see Figs. 1, and 4-6) for transmitting an e-mail to a destination via a mail server (terminal unit 60), the electronic mail communication method comprising storing a limit capacity of the mail server (RAM 13 or storage unit 20, column 4, line 59-column 5, lines 6), the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission (reference value table, column 5, lines 7-27, and column 7, lines 5-31, whereby the user sets a reference value of a maximum size that is transmitted, which subsequently would inherently indicate the maximum data amount that the mail server can store for one e-mail transmission), scanning image data (image reading unit 15, column 15, lines 7-11), the scanning not being performed at the mail server (see Fig. 1), converting the image data into data for Internet transmission (column 5, line 62-column 6, line 67), attaching the converted data to the e-mail (column 5, lines 16-67),

transmitting, to the destination, the e-mail to which the converted data is attached, via the mail server (column 5, line 16-column 6, line 67), comparing the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server before the e-mail to which the converted data is attached is transmitted to the destination via the mail server (column 5, line 16-column 6, line 17), notifying a user of the electronic mail communication apparatus of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server (column 5, lines 43-57, column 6, lines 57-67, see Fig. 6).

Regarding *claim 26*, Misawa discloses an electronic mail communication method (see Figs. 1 and 6) for transmitting image data to a destination via one mail server of the plurality of mail servers (terminal units 60 and facsimile units 80, column 3, lines 43-61), the one mail server being designated for the transmission (column 6, lines 24-53), the electronic mail communication method comprising storing a limit capacity (column 4, line 59-column 5, lines 6) and an IP address (see Fig. 2, whereby “tanaka@kk.co.jp” is considered an IP address) corresponding to each of the plurality of the mail servers (see Figs. 7 and 8, column 3, lines 43-61, and column 7, lines 21-27), the limit capacity indicating a maximum data amount that the mail server can store (reference value table, column 5, lines 7-27, and column 7, lines 5-31, whereby the user sets a reference value of a maximum size that is transmitted, which subsequently would inherently indicate the maximum data amount that the mail server can store for one e-mail transmission), scanning image data (image reading unit 15, column 15, lines 7-11), the scanning not performed at any of the plurality of the mail servers (see Fig. 1), converting the image data into data for

Internet transmission (column 5, line 62-column 6, line 67), attaching the converted data to the e-mail (column 5, lines 16-67), transmitting, to the destination, the e-mail to which the converted data is attached, via the mail server (column 5, line 16-column 6, line 67), comparing the data amount of the e-mail to which the converted data is attached with the limit capacity of the designated mail server (column 5, line 16-column 6, line 17), selecting another mail server that has a capacity to store the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the designated mail server (column 6, lines 13-67), transmitting, to the destination, the e-mail to which the converted data is attached via another mail server, based on the IP address corresponding to another mail server (column 6, lines 13-67, see Fig. 6).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Misawa *et al.* (U.S. Patent Number 6,771,382) in view of Toyoda *et al.* (U.S. Patent Number 5,881,233).

Regarding **claim 17**, Misawa discloses the communication apparatus discussed above in claim 16, but fails to expressly disclose of a speaker which notifies a user of the electronic mail communication apparatus of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server, via a sound.

Toyoda discloses an e-mail communication apparatus (see Figs. 11 and 28), that comprises a speaker (audio input/output device 14) which notifies a user of the electronic mail communication, via a sound (column 11, line 26-column 12, line 12).

Misawa & Toyoda are combinable because they are from the same field of endeavor, being systems that transmit e-mail. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the speaker taught by Toyoda within the system of Misawa, thereby including a speaker which notifies a user of the electronic mail communication apparatus of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server, via a sound. The suggestion/motivation for doing so would have been that Misawa's system would become more user-friendly, as the user would be notified via a sound, thus easily recognizing the notification, as is widely known within the art of systems having speakers. Therefore, it would have been obvious to combine the teachings of Toyoda with the system of Misawa to obtain the invention as specified in claim 17.

11. **Claims 20 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Misawa *et al.* (U.S. Patent Number 6,771,382) in view of Shoujima (U.S. Patent Number 5,754,778).

Regarding *claim 20*, Misawa discloses an electronic mail communication apparatus (see Fig. 1) transmitting an e-mail to a destination via a mail server (terminal unit 60), the electronic mail communication apparatus comprising a scanner configured to scan image data (image reading unit 15, column 15, lines 7-11), the scanner being distinct from the mail server (see Fig. 1), a memory configured to store a limit capacity of the mail server (RAM 13 or storage unit 20,

column 4, line 59-column 5, lines 6), the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission (reference value table, column 5, lines 7-27, and column 7, lines 5-31, whereby the user sets a reference value of a maximum size that is transmitted, which subsequently would inherently indicate the maximum data amount that the mail server can store for one e-mail transmission), and a controller (CPU 11) configured to convert the image data into data for Internet transmission (column 5, line 62-column 6, line 67), to attach the converted data to the e-mail (column 5, lines 16-67), and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server (column 5, line 16-column 6, line 67), the controller being further configured to compare the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server (column 5, line 16-column 6, line 17).

However, Misawa fails to expressly disclose of the controller configured to divide the image data into a plurality of pieces when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, to convert the divided image data into data for the Internet transmission , to attach each of the divided and converted data to an e-mail, and to transmit, to the destination, each e-mail to which the divided and converted data is attached, via the mail server.

Shoujima discloses an electronic mail communication apparatus (mail server 10) transmitting an e-mail to a destination via a mail server (receiving terminal 20, column 2, line 65-column 3, line 13), the electronic mail communication apparatus comprising a memory configured to store a limit capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission (column 4, lines 15-35),

and a controller (main control section 11) configured to convert the image data into data for Internet transmission, to attach the converted data to the e-mail, and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server (see Fig. 3, column 3, line 13-column 4, line 14), the controller being further configured to compare the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server (see Fig. 5, column 4, lines 22-45), to divide the image data into a plurality of pieces when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, to convert the divided image data into data for the Internet transmission (column 3, lines 13-47), to attach each of the divided and converted data to an e-mail, and to transmit, to the destination, each e-mail to which the divided and converted data is attached, via the mail server (see Fig. 3, column 3, line 13-column 4, line 14).

Misawa & Shoujima are combinable because they are from the same field of endeavor, being systems that transmit e-mail based on a memory capacity. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the e-mail dividing teachings of Shoujima within the system of Misawa. The suggestion/motivation for doing so would have been that Misawa's system would become more efficient, as the apparent time required for the reception of the electronic mail allows the operator to receive the electronic mail more efficiently, as recognized by Shoujima in column 2, lines 14-20. Therefore, it would have been obvious to combine the teachings of Shoujima with the system of Misawa to obtain the invention as specified in claim 20.

Regarding *claim 24*, Misawa discloses an electronic mail communication method (see Figs. 1 and 3-6) for transmitting an e-mail to a destination via a mail server (terminal unit 60),

the electronic mail communication method comprising storing a limit capacity of the mail server (via RAM 13 or storage unit 20, column 4, line 59-column 5, lines 6), the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission (reference value table, column 5, lines 7-27, and column 7, lines 5-31, whereby the user sets a reference value of a maximum size that is transmitted, which subsequently would inherently indicate the maximum data amount that the mail server can store for one e-mail transmission), scanning image data (image reading unit 15, column 15, lines 7-11), the scanning not being performed at the mail server (see Fig. 1), converting the image data into data for Internet transmission (column 5, line 62-column 6, line 67), attaching the converted data to the e-mail (column 5, lines 16-67), transmitting, to the destination, the e-mail to which the converted data is attached, via the mail server (column 5, line 16-column 6, line 67), comparing the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server (column 5, line 16-column 6, line 17).

However, Misawa fails to expressly disclose of dividing the image data into a plurality of pieces when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, converting the divided image data into data for the Internet transmission, attaching each of the divided and converted data to an e-mail, and transmitting, to the destination, each e-mail to which the divided and converted data is attached, via the mail server.

Shoujima discloses an electronic mail communication method (see Figs. 5-7) for transmitting an e-mail to a destination via a mail server (receiving terminal 20, column 2, line 65-column 3, line 13), the electronic mail communication method comprising storing a limit

capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission (column 4, lines 15-35), converting the image data into data for Internet transmission, attaching the converted data to the e-mail, transmitting, to the destination, the e-mail to which the converted data is attached, via the mail server (see Fig. 3, column 3, line 13-column 4, line 14), comparing the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server (see Fig. 5, column 4, lines 22-45), dividing the image data into a plurality of pieces when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, converting the divided image data into data for the Internet transmission (column 3, lines 13-47), attaching each of the divided and converted data to an e-mail, transmitting, to the destination, each e-mail to which the divided and converted data is attached, via the mail server (see Fig. 3, column 3, line 13-column 4, line 14).

Misawa & Shoujima are combinable because they are from the same field of endeavor, being systems that transmit e-mail based on a memory capacity. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the e-mail dividing teachings of Shoujima within the system of Misawa. The suggestion/motivation for doing so would have been that Misawa's system would become more efficient, as the apparent time required for the reception of the electronic mail allows the operator to receive the electronic mail more efficiently, as recognized by Shoujima in column 2, lines 14-20. Therefore, it would have been obvious to combine the teachings of Shoujima with the system of Misawa to obtain the invention as specified in claim 24.

12. **Claims 21 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Misawa *et al.* (U.S. Patent Number 6,771,382) in view of Toyoda (U.S. Patent Number 5,812,278).

Regarding **claim 21**, Misawa discloses an electronic mail communication apparatus (see Fig. 1) transmitting an e-mail to a destination via a mail server (terminal unit 60), the electronic mail communication apparatus comprising a scanner configured to scan image data (image reading unit 15, column 15, lines 7-11), the scanner being distinct from the mail server (see Fig. 1), a memory configured to store a limit capacity of the mail server (RAM 13 or storage unit 20, column 4, line 59-column 5, lines 6), the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission (reference value table, column 5, lines 7-27, and column 7, lines 5-31, whereby the user sets a reference value of a maximum size that is transmitted, which subsequently would inherently indicate the maximum data amount that the mail server can store for one e-mail transmission), and a controller (CPU 11) configured to convert the image data into data for Internet transmission (column 5, line 62-column 6, line 67), to attach the converted data to the e-mail (column 5, lines 16-67), and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server (column 5, line 16-column 6, line 67), the controller being further configured to compare the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server (column 5, line 16-column 6, line 17).

However, Misawa fails to expressly disclose of the controller configured to reduce the data amount of the image data by changing a resolution of the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail

server, to convert the reduced image data into data for the Internet transmission, to attach the converted data to an e-mail, and to transmit, to the destination, each e-mail to which the divided and converted data is attached, via the mail server.

Toyoda discloses an electronic mail communication apparatus (see Fig. 4, facsimile type electronic mail apparatus 21) transmitting an e-mail to a destination via a mail server (mail gateway 13, see Fig. 3), the electronic mail communication apparatus comprising a scanner configured to scan image data (scanning unit 25, column 11, lines 1-5), the scanner being distinct from the mail server (see Figs. 3 and 4), a memory configured to store a limit capacity of the mail server (column 12, lines 25-33), and a controller (CPU 30) configured to convert the image data into data for Internet transmission (column 11, lines 6-46), to attach the converted data to the e-mail (see Figs. 6 and 7), and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server (column 11, lines 6-46), the controller being further configured to compare the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server (column 12, lines 19-33), to reduce the data amount of the image data by changing a resolution of the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server (column 12, lines 19-62), to convert the reduced image data into data for the Internet transmission, to attach the converted data to the e-mail, and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server (column 12, lines 19-62, and column 14, lines 15-60).

Misawa & Toyoda are combinable because they are from the same field of endeavor, being systems that transmit scanned data as e-mail. At the time of the invention, it would have

been obvious to a person of ordinary skill in the art to use the e-mail resolution reduction teachings of Toyoda within the system of Misawa. The suggestion/motivation for doing so would have been that Misawa's system would become more efficient, as the transmission errors would be reduced, as recognized by Toyoda in column 2, lines 37-62. Therefore, it would have been obvious to combine the teachings of Toyoda with the system of Misawa to obtain the invention as specified in claim 21.

Regarding *claim 25*, Misawa discloses an electronic mail communication method (see Figs. 1 and 3-6) for transmitting an e-mail to a destination via a mail server (terminal unit 60), the electronic mail communication method comprising storing a limit capacity of the mail server (via RAM 13 or storage unit 20, column 4, line 59-column 5, lines 6), the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission (reference value table, column 5, lines 7-27, and column 7, lines 5-31, whereby the user sets a reference value of a maximum size that is transmitted, which subsequently would inherently indicate the maximum data amount that the mail server can store for one e-mail transmission), scanning image data (image reading unit 15, column 15, lines 7-11), the scanning not being performed at the mail server (see Fig. 1), converting the image data into data for Internet transmission (column 5, line 62-column 6, line 67), attaching the converted data to the e-mail (column 5, lines 16-67), transmitting, to the destination, the e-mail to which the converted data is attached, via the mail server (column 5, line 16-column 6, line 67), comparing the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server (column 5, line 16-column 6, line 17).

However, Misawa fails to expressly disclose of reducing the data amount of the image data by changing a resolution of the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, converting the reduced image data into data for the Internet transmission, attaching the converted data to an e-mail, and transmitting, to the destination, each e-mail to which the divided and converted data is attached, via the mail server.

Toyoda discloses an electronic mail communication method (see Figs. 4 and 5, via facsimile type electronic mail apparatus 21) for transmitting an e-mail to a destination via a mail server (mail gateway 13, see Fig. 3), the electronic mail communication method comprising storing a limit capacity of the mail server (column 12, lines 25-33), scanning image data (scanning unit 25, column 11, lines 1-5), the scanning not being performed at the mail server (see Figs. 3 and 4), comparing the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server (column 12, lines 19-33), reducing the data amount of the image data by changing a resolution of the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server (column 12, lines 19-62), converting the reduced image data into data for the Internet transmission, attaching the converted data to the e-mail, and transmitting, to the destination, the e-mail to which the converted data is attached, via the mail server (column 12, lines 19-62, and column 14, lines 15-60).

Misawa & Toyoda are combinable because they are from the same field of endeavor, being systems that transmit scanned data as e-mail. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the e-mail resolution reduction

teachings of Toyoda within the system of Misawa. The suggestion/motivation for doing so would have been that Misawa's system would become more efficient, as the transmission errors would be reduced, as recognized by Toyoda in column 2, lines 37-62. Therefore, it would have been obvious to combine the teachings of Toyoda with the system of Misawa to obtain the invention as specified in claim 25.

Citation of Pertinent Prior Art

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Feder (U.S. Patent Number 5,872,845) discloses a facsimile Internet server system.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
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jrp

